

AMENDMENTS TO THE DRAWINGS

The attached sheets of drawings include changes to Fig. 1. The changes to Fig. 1 are illustrated by the annotations in the attached Annotated Sheet. It is respectfully submitted that neither the changes to Fig. 1 adds any new matter to the application.

Attachments: Replacement Sheet
 Annotated Sheet showing changes

REMARKS

Claims 1-29, 31-34, 36-40, 42-49, and 51-57 are pending in the present application. Claims 1, 8-10, 12, 15, 17, 18, 21, 28, and 31 have been amended. Claims 1, 15, 17, 18, 21, 28, and 31 are independent claims. The Examiner is respectfully requested to reconsider the outstanding rejections in view of the above amendments and the following remarks.

Drawings

The Examiner objected to the drawings for failing to show various claimed elements. Particularly, the Examiner points out that the drawings do not show (1) the digital camera which directly communicates with the delivery-medium producing apparatus, and (2) the controller for controlling the capturing device and wireless communications being an integral component of the camera.

Attached hereto is a corrected drawing to Fig. 1 illustrating a digital camera 20' into which the mobile phone functionality is integrally formed therein. Applicants respectfully submit that such correction to Fig. 1 does not add new matter to the present application. This correction is supported, e.g., in page 22, line 34 – page 23, line 2. As such, corrected Fig. 1 now clearly illustrates a digital camera 20' with wireless communication functionality built therein. Accordingly, it is clear from corrected Fig. 1 that the internal controller of digital camera 20' would control both the camera functionality as well as the wireless communication functionality.

Furthermore, the specification has been amended to make reference to reference number 20' added to the corrected drawing.

In view of the aforementioned drawing correction, the Examiner is respectfully requested to reconsider and withdraw this objection.

Rejections Under 35 U.S.C. § 112

Claims 1, 15, 17, 21, 28, and 31 stand rejected under 35 U.S.C. § 112, 1st paragraph, for allegedly failing to comply with both the enablement requirement and the written description requirement. This rejection is respectfully traversed.

Enablement

The Examiner asserts that the following elements in claims 1, 15, 17, 21, 28, and 31 are not enabled:

“... a receiving unit configured to receive the plurality of images via wireless communications with the one or more digital cameras”

“... a controller operable to control said capturing device and to control a communication device capable of being connected to said capturing device to wirelessly communicate with an external apparatus, wherein...”

“wherein the external apparatus is adapted to automatically store said plurality of images captured and transmitted by a plurality of capturing devices and to create image IDs respectively assigned to said plurality of images, each of said image IDs being linked to a predetermined web page on the internet.”

In this rejection, the rationale proffered by the Examiner as to why the aforementioned claim features are not enabled is that “the applicant has failed to provide any support within the specification, which discloses a digital camera that communicates wirelessly to a receiving unit of a delivery-medium producing apparatus” (Office Action at page 3). Applicants respectfully disagree with this assertion by the Examiner. Specifically, Applicants respectfully refer the Examiner to page 22, line 32 – page 23, line 2 of the original specification, which states the following:

“In the above description, an example in which the digital camera 20 and the mobile phone 30 are separate components is described. Alternatively, the digital camera 20 and the mobile phone 30 may be formed integrally to be a single device” (emphasis added).

This passage of the original specification clearly describes that the functionalities of the mobile phone (which wirelessly communicates with the receiving unit of the delivery-medium producing apparatus) may be integrated into the digital camera. As such, the specification does provide support the aforementioned claim limitations. Accordingly, the aforementioned claim limitations are enabled.

In view of the foregoing, Applicants respectfully submit that claims 1, 15, 17, 21, 28, and 31 satisfy the enablement requirement of § 112, 1st paragraph. Therefore, the Examiner is respectfully requested to reconsider and withdraw this rejection.

Furthermore, Applicants wish to address the following statement made by the Examiner in the Response to Arguments:

“Moreover, the Examiner asserts that the applicant is relying on what one of ordinary skill in the art would have found obvious and well known in the art in order to understand the method of a camera directly communicating with a delivery-medium producing apparatus without the assistance of a mobile phone and, as such, the Examiner will take the above made statement that the method of a camera wirelessly communicating with a delivery-medium producing apparatus, with or without a mobile phone, is old and well known and would have been well within the skill of one having ordinary skill in the art” (Office Action at pages 41-42).

Applicants respectfully submit that this is a mischaracterization of Applicants’ arguments in the Amendment filed January 30, 2009 (hereafter “the previous Amendment”). In the previous Amendment, Applicants argued the following:

“persons of ordinary skill in the technical field would know how to implement a mechanism other than a [separate] mobile phone to perform wireless communications between the digital camera and delivery-medium producing apparatus, without undue experimentation” (the previous Amendment at page 19; emphasis added).

Such statement is not an admission that wireless communications between a digital camera and a delivery-medium producing apparatus would have been obvious or well known in the art.

Applicants were simply making the point that persons of ordinary skill in the art would have been enabled to implement such features in view of Applicants' original specification.

Written Description

1. “a receiving unit configured to receive the plurality of images via wireless communications with the one or more digital cameras”

The Examiner asserts that the following claim element does not comply with the written description requirement: “... a receiving unit configured to receive the plurality of images via wireless communications with the one or more digital cameras” The Examiner’s rationale for this rejection is as follows:

“[N]owhere in the specification nor in the drawings does the applicant disclose a receiving unit that communicates with a digital camera through wireless communication. On the contrary, the applicant has only disclosed that a mobile phone is required in order for the digital camera to communicate with the receiving unit” (Office Action at page 4).

Applicants respectfully disagree with this statement. Applicants again respectfully refer the Examiner to page 22, line 32 – page 23, line 2 of the original specification, which clearly discloses that the functionalities of the mobile phone (including that of wirelessly communicating the digital images to the receiving unit of the delivery-medium producing apparatus) may be integrated into the digital camera. As such, the original specification **does** disclose that a receiving unit of the delivery-medium producing apparatus may communicate with a digital camera through wireless communication.

In view of the foregoing, Applicants respectfully submit that the aforementioned claim limitation satisfies the written description requirement of § 112, 1st paragraph. Therefore, the Examiner is respectfully requested to reconsider and withdraw this rejection.

2. “controller”

The Examiner asserts that “The Examiner is unable to find any support in the specification that the controller, which controls the transmission function of the camera, is part of

the camera itself or whether it is an external device that is connected to the camera, thereby forming a capturing device that comprises a camera and a controller” (Office Action at pages 4-5). Applicants presume that the Examiner intended to apply this particular ground of rejection only to independent claim 21, since this is the only independent claim reciting a “controller” as part of the capturing device.

Initially, Applicants point out that this constitutes a **new ground of rejection not necessitated by previous amendment**. Therefore, Applicants respectfully submit that the finality of the outstanding Office Action is **improper** in view of this new ground of rejection. See MPEP § 706.07(a), 4th paragraph. Accordingly, this Office Action should be treated as a **non-final** Office Action, and the amendments listed above should be entered.

Furthermore, Applicants respectfully submit that the controller of claim 21 finds support in the original specification in page 9, lines 14-27 (“The digital camera 20 ... includes ... a controller operable to control operations of the digital camera 20.... The digital camera 20 may control the mobile phone 30 to communicate with the delivery-medium producing apparatus 10”). It is inherent from such disclosure that when the digital camera controls the mobile phone, it is the digital camera’s controller which is controlling the mobile phone.

In view of the foregoing, Applicants respectfully submit that the aforementioned claim element satisfies the written description requirement of § 112, 1st paragraph. Therefore, the Examiner is respectfully requested to reconsider and withdraw this rejection.

Prior Art Rejections

Claims 1-14, 28, 36, 42, 43, and 48 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,666,215 to Fredlund et al. (hereafter “Fredlund”) in view of U.S. Patent No. 6,750,902 to Steinberg et al. (hereafter “Steinberg”). Claim 29 stands rejected under § 103(a) as being unpatentable over Fredlund and Steinberg in view of U.S. Patent No. 5,737,491 to Allen et al (hereafter “Allen”). Claims 31-34, 49, and 57 stand rejected under § 103(a) as being unpatentable over Fredlund and Steinberg in view of Japanese Patent Publication

10078918 to Enomoto et al (hereafter “Enomoto”). Claims 15-17, 44, 45, 52, and 53 stand rejected under § 103(a) as being unpatentable over Enomoto in view of Steinberg. Claims 18-27, 37-40, 46, 47, 54, and 55 stand rejected under § 103(a) as being unpatentable over Allen in view of Steinberg. These rejections, insofar as they pertain to the presently pending claims, are respectfully traversed.

Initially, Applicants incorporate herein by reference the arguments presented in the previous Amendment of January 30, 2009. Applicants respectfully submit that the claims are allowable at least for the reasons set forth in such arguments. However, in an effort to expedite prosecution, Applicants have amended the claims above to further distinguish over the cited references.

Particularly, independent claims 1, 15, 17, 28, and 31 have been amended to recite the following features:

- the one or more recording media on which the images are recorded includes a printed photograph,
- the one or more recording media are to be delivered to a user, and
- the delivery-medium producing apparatus (or site) includes an extra-printing request unit (or functionality) for receiving from the user via the Internet an extra-printing request including at least one of the image IDs linked to the predetermined web page, the request causing an extra-printed photograph to be delivered to the user.

Independent claims 18 and 21 recite similar features, in which the “external apparatus” is analogous to the delivery-medium producing apparatus/site mentioned above.

Applicants respectfully submit that none of Fredlund, Steinberg, Allen, and Enomoto, taken separately or in obvious combination, teaches or suggests the aforementioned claim features. It is noted that the Examiner’s rejection cites to Fredlund to teach “a system and method for facilitating ordering and re-ordering of prints from negatives” (Office Action at page 9). However, Fredlund does not teach or suggest any unit or functionality for receiving an extra-

printing request via the Internet which includes an image ID linked to a predetermined web page on the Internet, as claimed. As such, the claimed invention is able to provide a way for the user to easily order extra prints via the Internet and to receive them, which is neither taught nor suggested by Fredlund and the other references, taken separately or in obvious combination.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Since the cited references do not teach or suggest every claimed feature, as discussed above, this rejection has been obviated.

At least for the reasons set forth above, independent claims 1, 15, 17, 18, 21, 28, and 31 are in condition for allowance. Accordingly, claims 2-14, 16, 19, 20, 22-27, 29, 32-34, 36-40, 42-49, and 51-57 are allowable at least by virtue of their dependency on allowable independent claims. Therefore, the Examiner is respectfully requested to reconsider and withdraw this rejection.

Conclusion

Applicants respectfully submit that this Amendment After Final should be entered at least for the reason that the current Office Action was improperly made final since it includes a new ground of rejection (under 35 U.S.C. § 112, 1st paragraph) which was not necessitated by amendment.

In view of the above amendments and remarks, the Examiner is respectfully requested to reconsider the outstanding rejections and issue a Notice of Allowance in the present application.

Should the Examiner believe that any outstanding matters remain in the present application, the Examiner is respectfully requested to contact Jason W. Rhodes (Reg. No. 47,305) at the telephone number of the undersigned to discuss the present application in an effort to expedite prosecution.

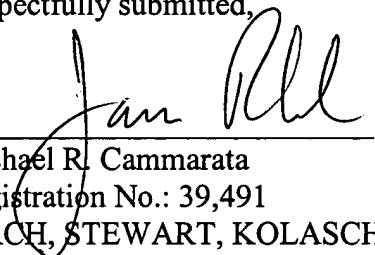
Application No. 09/892,769
Amendment dated July 14, 2009
After Final Office Action of May 5, 2009

Docket No.: 3562-0118P

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

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ANNOTATED SHEET

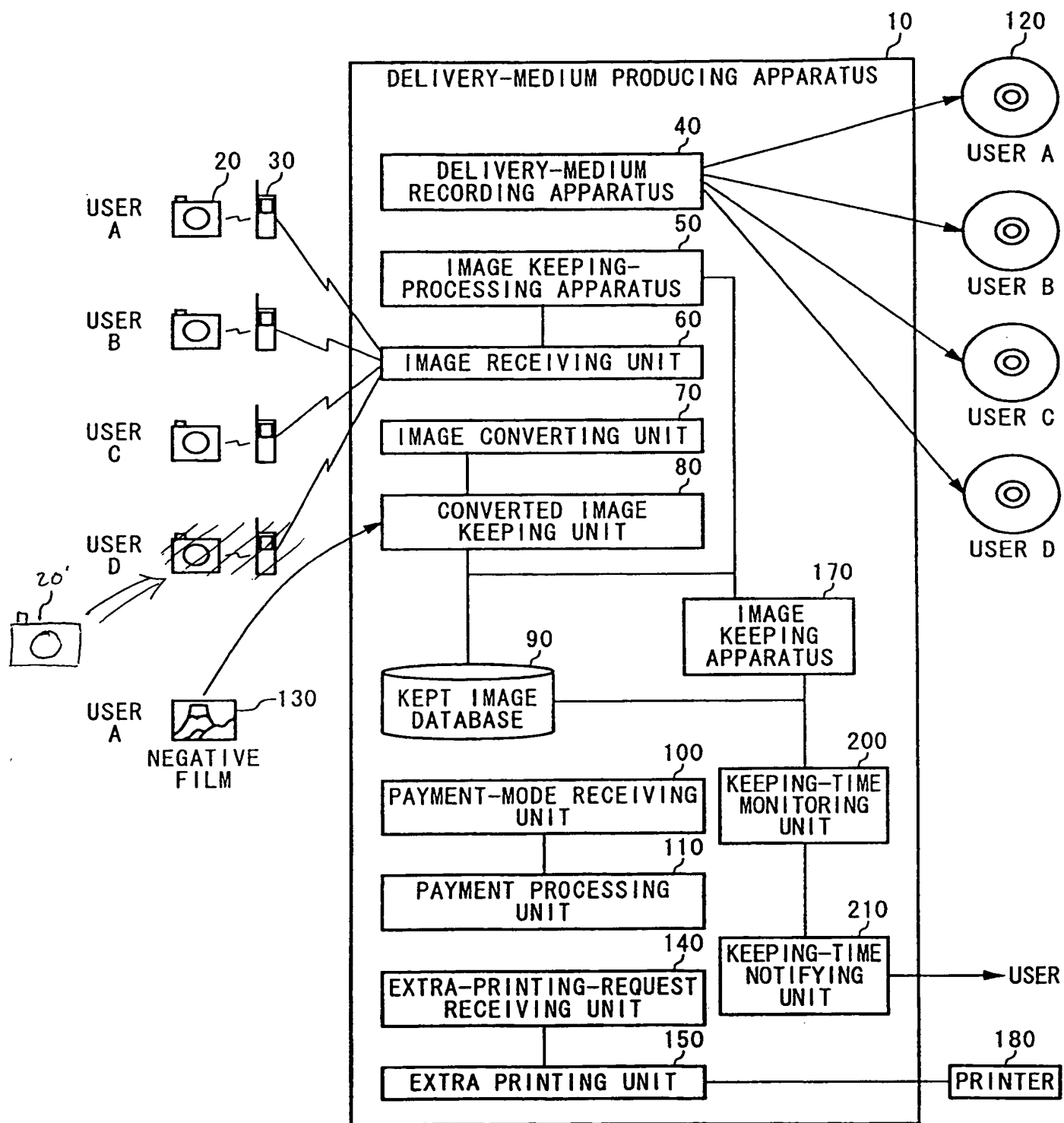


FIG. 1